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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/710,011	06/11/2004	Shyam K. Gupta		4010

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EXAMINER

CHUI, MEI PING

ART UNIT	PAPER NUMBER
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1616

MAIL DATE	DELIVERY MODE
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09/10/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.		Applicant(s)	
	10/710,011		GUPTA, SHYAM K.	
	Examiner		Art Unit	
	Helen Mei-Ping Chui		1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☒ Claim(s) 1-10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>None</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Action

The Examiner acknowledges receipt of application number 10/710,011 filed on 06/11/2004. Claims 1-10 are presented for examination on the merits for patentability.

Notes to the Applicant

It is noted to the Applicant that the symbols [c1], [c2], etc designates before each claim is confusing and is not necessary because all claims have been numbered accordingly. Applicant is advised to remove the symbol.

Claims Objection

Claims 1-10 are objected because of the non-compliance with the text font size and style. Text should be written in a nonscript type font (e.g., Arial, Times Roman, or Courier, preferably a font size of 12). (See MPEP 608.01)

DOUBLE PATENTING

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 1-4 and 8-10 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 14-20 of co-pending U.S. Patent Application No. 10/605,191. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of claims 14-20 of co-pending U.S. Patent Application No. 10/605,191 instantly claimed subject matter where both instant and conflicting claims are drawn to a composition comprising a divalent metal zeolite and a carrier base described therein in the claims.

Therefore, one of ordinary skill in the art, at the time the claimed invention was made, would have readily recognized that claims 14-20 found in co-pending U.S. Patent Application No. 10/605,191 and claim 1-4 and 8-10 in the instant application are obvious variant and are not patentability distinct to each other.

Claim Rejections - 35 USC § 112 second paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claim 10 is rejected 35 U.S.C. 112, second paragraph, because a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by

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"parenthesis" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 10 recites the broad recitation, surfactants, and the claim also recites cationic, anionic, non-ionic, amphoteric, and zwitterionic, which is the narrower statement of the range/limitation.

Claim Rejection - 35 U.S.C. § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102(b) that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Strianse et al. (U.S. Patent No. 4,362,715).

With respect to instant claims 1 and 3-7, Strianse et al. disclose a cosmetic vehicle comprising a polymer and zeolite mixes with amorphous form of aluminosilicate to form a creamy gel as the cosmetic delivery system (Abstract: line 1-3). Strianse et al. also disclose that the zeolites can be crystalline metal aluminosilicates (column 1, line 54-56). The zeolite-

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alumino-silicate complex contains Al^{3+} cation and 8-250 number of water molecules in the structure (column 2, line 15: see complex formula; line 19 and 27). Therefore, claims 1 and 3-7 are anticipated.

With respect to instant claims 8-10, Strianse et al. further disclose that the cosmetic vehicle is effective for cleansing creams and anti-acne creams (column 2, line 66-68). It can also include pigments, perfumes, odorants, powders, i.e. talc, and various surfactants (column 3, line 5-8). Strianse et al. disclose that the cosmetic vehicle described therein is a creamy gel, a lotion, a stick type formulation (column 3, line 11-13), a cream or a liquid (column 4, Example 4, line 63 or column 5, Example 13, line 50-51). Therefore, claims 8-10 are anticipated.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102(e) that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Araya, A. (U.S. Patent Application 2003/0148876).

With respect to instant claims 1-3, 5-7 and 9, Araya, A. discloses a powder mixture of a crystalline aluminosilicate (page 2, paragraph 0024, line 2-3 and paragraph 0025) and a salt of second metal consisting of titanium or zinc (page 2, paragraph 0027, line 1-4) which is sufficient

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to replace parts of the first metal moiety contains in zeolite (page 2, paragraph 0027, line 6-7).

Therefore, claims 1-3, 5-7 and 9 are anticipated.

With respect to instant claim 4, Araya, A. discloses that the powder mixture can be a “dry” mixture where no water is added when it is prepared (page 2, paragraph 0028, line 1-2), or the powder mixture is hydrated form, particularly preferred hexadecahydrate (page 2, paragraph 0028, line 7 and 9). Therefore, claim 4 is anticipated.

With respect to instant claim 8, Araya, A. also discloses that the physical form of the composition could be a powder, liquid, gel or solid bar (page 2, paragraph 0030, line 11) or cream (page 3, paragraph 0041, line 3). Therefore, claim 8 is anticipated.

With respect to instant claim 10, Araya, A. further discloses that the composition may include one or more surfactants, preferably selected from anionic, non-ionic, amphoteric and zwitterionic and mixtures thereof (page 3, paragraph 0042, line 1-4). Therefore, claim 10 is anticipated.

Notes to Applicant

With respect to the art rejections set forth above, it is noted that the reference of Strianse et al. and Araya et al. do not disclose that the composition can be used in the manner instantly claimed in claims 5-7; however, the intended use of the claimed composition does not patentably distinguish the composition, per se, since such undisclosed use is inherent in the reference composition. In order to be limiting, the intended use must create a structural difference between

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the claimed composition and the prior art composition. In the instant case, the intended use does not create a structural difference, thus the intended use is not limiting.

With respect to the art rejections set forth above, it is noted to the Applicant that the patentability of a product in instant claim 3 does not depend on its method of production. If the product in the product-by-process claims is the same or obvious from the product in the prior art, the claim will be held unpatentable even if the prior product is made by a different process (see MPEP 2113).

Conclusion

No claims are allowed.

Contact Information

Any inquiry concerning this communication from the Examiner should direct to Helen Mei-Ping Chui whose telephone number is 571-272-9078. The examiner can normally be reached on Monday-Thursday (7:30 am – 5:00 pm). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where the application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either PRIVATE PAIR or PUBLIC PAIR. Status information for

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unpublished applications is available through PRIVATE PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the PRIVATE PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Johann R. Richter", with a large, stylized initial "J" and a horizontal line extending from the end of the signature.

Johann R. Richter

Supervisory Patent Examiner

Technology Center 1600